#8 DMT 3-14-02

Docket No.: PC-0025 CIP

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By: _____ Printed: Katherine Stofer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael G. Walker

Title: **ANKYRIN REPEAT DOMAIN 2 PROTEIN VARIANT**

Serial No.: 09/758,953 Filing Date: January 10, 22001

Examiner: Holbrook, P.G. Group Art Unit: 1647

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This paper is responsive to the Restriction Requirement and Request for Election dated January 29, 2002, setting a one month term for response.

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1-3 and 4-6) drawn to polynucleotides, a vector and a host cell.

Group II (claims 13-14) drawn to polypeptides.

Group III (claims 17-18) drawn to antibodies.

Group IV (claims 7-10) drawn to a method of using a polynucleotide to detect expression of a polynucleotide.

Group V (claims 11-12) drawn to a method to screen compounds that bind to a polynucleotide.

Group VI (claims 15-16) drawn to a method to screen for a ligand using a protein.

Group VII (claims 19-20) drawn to a method to diagnose a condition using an antibody.

The Examiner has further required an election from SEQ ID NOs:1-12 as independent and distinct inventions.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to

claims 1-6. Within that group, Applicants elect the full length sequence of a polynucleotide encoding SEQ ID NO:1, which includes SEQ ID NO:2, again with traverse. Applicants object to the requirement to elect between SEQ ID NOs:1-12 as independent and distinct inventions that would provide an undue burden of search on the Examiner. It is unclear how the requirement applies to claim 1 which recites a nucleic acid sequence encoding SEQ ID NO:1 and includes SEQ ID NO:2. Clearly both SEQ ID NO:1 and SEQ ID NO:2 are encompassed by the claim. Applicants further submit that the inclusion of SEQ ID NOs:3-10 in the search of a polynucleotide sequence encoding SEQ ID NO:1, as elected, would not constitute an undue burden of search upon the Examiner as SEQ ID NOs:3-6 are described in the specification as fragments of SEQ ID NO:2, a polynucleotide encoding SEQ ID NO:1, and SEQ ID NOs:7-10 are variants of SEQ ID NO:2 that share from 82% to 91% sequence identity with SEQ ID NO:2. SEQ ID NOs:11-12 are not recited in the claims as they are GenBank sequences in the public domain. All of the sequences SEQ ID NOs:3-10 would be found in a single search of the prior art for sequences related to SEQ ID NO:2. Applicants refer the Examiner to the MPEP § 803: Restriction-When Proper:

> There are two criteria for a proper requirement for restriction between patentably distinct inventions:
>
> (A) The inventions must be independent (see MPEP Section 802.01 Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and
> (B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02 Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02). (Emphasis added).

Applicants submit that while requirement (A) may be met in the instant case, requirement (B) clearly has not. The Examiner's contention that the searches for these sequences are not coextensive is therefore incorrect. Furthermore, claims 7-10 and 11-12, encompassed by Groups IV and V are all methods of use the the polynucleotides of Group I that depend from and are therefore of the same scope as the polynucleotides of Group I, and could be examined together with the compositions themselves without undue burden.

Applicants therefore request reconsideration and examination of all sequences in the claims of elected Group I, as well as rejoining the method of use claims dependent from the claims of Group I,

claims 7-12, Groups IV and V. In the event the Examiner maintains the restriction, Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108.**

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: February 26, 2002 David G. Streeter

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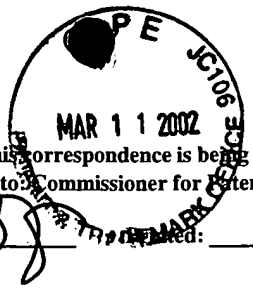

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Title: ANKYRIN REPEAT DOMAIN 2 PROTEIN VARIANT

Serial No.: 09/758,593 Filing Date: January 10, 2001

Examiner: Holbrook, P.G. Group Art Unit:1647

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TRANSMITTAL FEE SHEET

Sir:

Transmitted herewith are the following for the above-identified application:

1. Return Postcard;
2. Response Transmittal Fee Sheet (1 pg., in duplicate); and
3. Response to Restriction Requirement (3 pp.).

The fee has been calculated as shown below.

Claims	Claims After Amendment	-	Claims Previously Paid For	=	Present Extra	Other Than Small Entity Rate	Fee	Additional Fee(s)
Total Claims	20	-	20	=		$18		$ 0
Indep. Claims	3	-	3	=		$84		$ 0
__ First Presentation of Multiple Dependent Claim +$280								$ 0
						TOTAL		$ 0

__X__ No additional fee is required.
_____ Fee for Request for Extension of Time (___ months) $_____
_____ Please charge Deposit Account No. 09-0108 the amount of $_____

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17, or credit overpayment to Deposit Account No. **09-0108**. **A duplicate copy of this sheet is enclosed.**

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: February 26, 2002 David G. Streeter

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